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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,220

11/26/2003

Shon R. Pulley

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05/30/2006

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/723,220	Applicant(s) PULLEY ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1,3-19,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 3-19, 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1, 3-19, 22, 24 are pending in this application.

Claim 22 is drawn to non-elected inventions.

Claims 2, 20, 23 are cancelled.

***Restriction Requirement***

This confirms that claim 20 is infact not included in the invention of group I.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-18, 21, 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Fobian et al., WO 2004022523 (priority date 9/6/02).

Fobian et al., disclose compounds in the attached abstract.

Claims 1, 3-18, 21, 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Birkus et al., WO 2003090691 (priority date 4/26/02).

Birkus et al., disclose compounds in the attached abstract.

Claims 1, 3-18, 21, 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Varghese et al., WO 2003040096.

Varghese et al., disclose compounds in the attached abstract.

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Applicant's arguments filed 4/14/06 have been fully considered but they are not persuasive. Applicant contends that the instant invention claims the benefit of a provisional application filed 11/27/02. This is not persuasive because Fobian et al., has a provisional application No US2002-408783P, filed 9/6/02 and the provisional application No US2002-375622P, of Birkus, et al., was filed 4/26/02. Applicant also contends that the prior art of Varghese et al., was published after the priority date of the instant invention. This is not persuasive because the invention of Varghese et al., was published before the filing date of the instant invention and Varghese et al., provisional application, US2001-337122P, was filed, 11/8/01.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-18, 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over all the prior arts cited above, individually.

Applicant claims compounds of claims 1, 1, 3-18, 21, 24.

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

Each prior art teaches the compounds cited above and methods of using the compounds. See the citations.

#### **Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant invention and that of the prior arts is that Applicant claims H instead of alkyl and vice versa in some of the species embraced by the generic

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formulae. In other species Applicant claims compounds wherein the length of a carbon chain is either longer or shorter than that of the prior arts.

*Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)*

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950). For the compounds of the prior art to be used for the stated utilities they must be used in form of compositions. Therefore, the instant invention is prima facie obvious from the teaching of the prior arts. One of ordinary skill in the art would have known to claim the compounds and their compositions at the time the invention was made. The motivation is from the teachings of prior arts that the compounds have utilities, from knowing that H and alkyl are equivalents and that adjacent homologs would have similar physical and biochemical properties.

Applicant's arguments filed 4/14/06 have been fully considered but they are not persuasive. Applicant contends that there was no motivation in the prior arts to modify compounds of the prior arts. This is not persuasive for reasons set forth above.

***Rejoinder***

Rejoinder of claim 22 as requested by applicant would be as set forth in the rejoinder clause of the Restriction Requirement (9/22/05). That is, when the compound claims are in

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condition for allowance, claim 22 would be rejoined. Applicant should note that such rejoinder is deemed an amendment and subject to appropriate Rules of amendment after FINAL.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

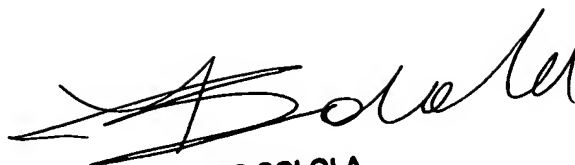
#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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A handwritten signature in black ink, appearing to read 'Taofiq Solola', written in a cursive style.

**TAOFIQ SOLOLA  
PRIMARY EXAMINER**

Group 1626

May 16, 2006